

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	REQUEST DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/743,644	4/21/04	RODRIGUEZ	0110-0001

Title: **CORDLESS TELEPHONE-TO-SOUND CARD  
INTERFACE ADAPTER HAVING A HYBRID  
TRANSFORMER CIRCUIT**

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Art Unit	Paper Number
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Correspondence Address:

JOHN J. OSKOREP  
ONE MAGNIFICENT MILE CENTER  
SUITE 1400  
980 N. MICHIGAN AVENUE  
CHICAGO, IL. 60611

PATENT & TRADEMARK OFFICE  
MAILED

SEP 02 2004

LICENSING & REVIEW

Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 533,155  
Grant Date: 02-Sep-04

This license is granted retroactively to the date(s) and the country(s) indicated on the attached decision.

Approved

  
for Commissioner of Patents and Trademarks

This license empowers the filing, the causation and the authorization of the filing of a foreign application or applications on the subject matter identified above, subsequent forwarding of all duplicate and formal papers and the prosecution of such application or applications.

This license does not empower the filing of any applications, amendments, supplements or continuances originating in this country which disclose inventions, modifications, or variations not disclosed in the subject matter identified above.

This license is to be retained by the licensee and may be used at anytime on or after the date thereof. This license is not retroactive unless specifically indicated.

The grant of this license does not in any way lessen the responsibility of the licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations, especially with respect to certain countries, of other agencies, particularly the Office of Foreign Assets Control, Department of the Treasury; Office of Munitions Control, Department of State (with respect to Arms, Munitions and Implements of War); the Bureau of Trade Regulation, Office of Export Administration, Department of Commerce; and the Department of Energy.

**LICENSE FOR FOREIGN FILING**

[Title 35, United States Code (1952) Sections 184, 185, 186]

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
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John J. Oskorep, Esq.  
One Magnificent Mile Center  
980 N. Michigan Avenue, Suite 1400  
Chicago, Illinois 60611

In re: Rodriguez. : DECISION ON REQUEST  
Serial No.: 10/743,644 : UNDER 37 CFR 5.25  
Filing date: December 22, 2003  
Docket No: 0110-0001

**Title: CORDLESS TELEPHONE-TO-SOUND CARD INTERFACE ADAPTER  
HAVING A HYBRID TRANSFORMER CIRCUIT**

This is a decision on the petition filed on August 2, 2004 for retroactive foreign filing license.

It has been determined that a retroactive license for foreign filing under 35 U.S.C.184 be granted with respect to the filings listed below. The petition complies with 37 C.F.R. 5.25 in that there is an adequate showing that the subject matter in question was not under a secrecy order, that the license was diligently sought after discovery of the proscribed foreign filing, and that the material was filed abroad without the required license under 37 C.F.R 5.11 through error and without deceptive intent.

**Country**

**Date**

Mexico

July 2, 2003

Ian J. Lobo  
Patent Examiner  
(703) 306-4161



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

RODRIGUEZ

Serial No.: 10/743,644

Filing Date: 12/22/2003

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)  
)  
)

Group No.: N/A

Examiner: N/A

Docket No.: 0110-0001

Entitled:

"CORDLESS TELEPHONE-TO-SOUND CARD INTERFACE ADAPTER  
HAVING A HYBRID TRANSFORMER CIRCUIT"

RECEIVED

AUG 5 2004

LICENSING & REVIEW

MAIL STOP PETITION  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE TO COMMUNICATION REGARDING PETITION  
FOR RETROACTIVE LICENSE UNDER 37 CFR SECT. 5.25**

The Applicant respectfully submits this paper in response to the Communication from the USPTO mailed on 24 May 2004 regarding the Petition For Retroactive License Under 37 CFR Sect. 5.25 filed on 21 April 2004 for the above-referenced patent application.

**RESPONSE TO COMMUNICATION REGARDING PETITION  
FOR RETROACTIVE LICENSE UNDER 37 CFR SECT. 5.25**

The Applicant submits this paper in response to the Communication from the USPTO mailed on 24 May 2004 regarding the Petition For Retroactive License Under 37 CFR Sect. 5.25 for U.S. patent application entitled "CORDLESS TELEPHONE-TO-SOUND CARD INTERFACE ADAPTER HAVING A HYBRID TRANSFORMER CIRCUIT" (Inventor Luis Ricardo Rodriguez) having U.S. Serial No. 10/743,644 and a filing date of December 22, 2003.

In the Communication, it was indicated that the Petition was denied as not meeting the requirements of 37 CFR 5.25 (1) (2) and (3)(ii-iii).

In response, the Applicant respectfully requests reconsideration of the Petition. The requirements for a retroactive license have indeed been met and further support is provided herewith. Upon reconsideration, the Applicant respectfully submits that the Petition should be granted for the following reasons.

As indicated in the communication, 37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed;
2. The dates on which the material was filed in each country;
3. A verified statement (oath or declaration) containing:
  - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order;
  - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing;
  - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under Sect. 5.11 first having been obtained; and
4. The required fee (Sect. 1.17(h)).

The Communication indicated that the petition was denied due to the following specific objections: (1) a listing of each foreign country and associated filing dates was not included; (2) a copy of the application in English was not included; and (3) the evidence provided to conclude that the material was filed abroad through error and without deceptive intent was insufficient.

Response to Objection (1). In response to (1) above, the Applicant respectfully submits that the Petition did indeed provide a listing of each of the foreign countries in which the unlicensed patent application was filed and the dates on which the material was filed in each country. That listing was provided in the Petition on page 2, paragraph 2. It is a possibility that this information was overlooked. There is only one foreign country for which a patent filing was made: Mexico. The Applicant provides this information again below in a more formal manner:

<u>Country</u>	<u>Application No.</u>	<u>Application Title</u>	<u>Filing Date</u>
Mexico	PA/a/2003/005992	Device Allowing Connection of Wireless Telephone to Computer for Internet Telephony	2 July 2003

Thus, objection (1) should now be overcome.

Response to Objection (2). In response to (2) above, the Applicant respectfully submits that a copy of the patent application in English was indeed provided with the Petition. It is a possibility that the material was also overlooked or lost. In any case, the Applicant again submits copies of the Mexican patent application herewith in both Spanish and English (translation of the Mexican patent application). Thus, objection (2) should now be overcome.

**Response to Objection (3).** In objection (3) above, it was indicated specifically in the Communication that the Petition “fails in that it lacks sufficient evidence to conclude that the material was filed abroad through error and without deceptive intent. Sufficient evidence would include a verified statement or statements by the person or persons (in the instant case British [sic] counsel) who had knowledge and made the actual decision to file. Such a statement should reference the error of not obtaining a foreign license. Statements of error must be supported by fact. They should not be merely conclusionary but must include how and why the error occurred.”

In response to objection (3) above, the Applicant had indeed submitted a verified statement by the inventor Mr. Rodriguez who had knowledge and played a part in the actual decision to file. See e.g. page 1 at lines 12-14 of the Declaration of Luis Ricardo Rodriguez. This Declaration does indeed reference the error of not obtaining the foreign license. See e.g. page 1 at lines 12-14, page 2 at lines 6-8, and page 3 at lines 4-5. This Declaration is also supported by fact and includes how and why the error occurred. See e.g. page 2 at lines 8-20, and page 3 at lines 4-5. In addition, the Applicant had also submitted a Declaration from Mr. Rodriguez’s patent attorney, John J. Oskorep, the undersigned, who confirms Mr. Rodriguez’s actions and intent. The Applicant submits copies of these Declarations again in the event they were misplaced or overlooked.

In addition, the Applicant submits herewith an additional Declaration of Mr. Arturo Bustamante. Mr. Bustamante was the Mexican agent who prepared and filed the Mexican patent application for Mr. Rodriguez. Along with Mr. Rodriguez, Mr. Bustamante filed the subject matter abroad through error and without deceptive intent. Reviewing his Declaration, Mr. Bustamante had direct knowledge and played a part in the actual decision to file. See e.g. page 1 at lines 2-5. This statement does indeed reference the error of not obtaining the foreign license. See e.g. page 1 at lines 10-19 through page 2 at lines 1-3, as well as page 2 at lines 6-7. Mr. Bustamante’s statement is also indeed supported by fact and includes how and why the error occurred. See e.g.

page 1 at lines 8-13, page 1 at lines 15-19, page 2 at lines 2-5, and page 2 at lines 6-7.  
Thus, objection (3) should now be overcome.

Final Comments. The Applicant again respectfully requests reconsideration of the Petition. All requirements have been met and further support is provided herewith. The specific concerns regarding (1), (2), and (3) above have been overcome. For the reasons provided herein, the Applicant respectfully requests that the Petition be granted.

Note that we continue to be diligent in the pursuit of the retroactive license. I personally became aware of this issue during the week of March 22 – 26<sup>th</sup> 2004 and I diligently took steps during the subsequent weeks to produce and file the initial Petition. I continue with my diligence by filing this Response within the specified timeframe in the Communication.

Thank you. Please feel free to contact the undersigned for any reason if it would expedite the handling of this matter.

Date:

29 June 2004

JOHN J. OSKOREP, ESQ.  
ONE MAGNIFICENT MILE CENTER  
980 N. MICHIGAN AVENUE, SUITE 1400  
CHICAGO, ILLINOIS 60611

Telephone: (312) 222-1860 Fax: (312) 214-6303

Attachments:

- (1) Copy of Mexican patent application;
- (2) Copy of English translation of Mexican patent application;
- (3) Copy of Declaration of Luis Ricardo Rodriguez;
- (4) Copy of Declaration of John J. Oskorep; and
- (5) Copy of Declaration of Mr. Arturo Bustamante.

Respectfully Submitted,

JOHN J. OSKOREP  
Reg. No. 41,234

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/743,644	21-Apr-04	RODRIGUEZ	0110-0001

Title: CORDLESS TELEPHONE-TO-SOUND CARD  
INTERFACE ADAPTER HAVING A HYBRID  
TRANSFORMER CIRCUIT

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Art Unit	Paper Number
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Correspondence Address:

JOHN J. OSKOREP  
ONE MAGNIFICENT MILE CENTER  
SUITE 1400  
980 N. MICHIGAN AVENUE  
CHICAGO, IL. 60611

*Miled n.k.*  
~~RECEIVED~~  
MAY 24 2004  
LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the  
Petition for Retroactive License under 37 CFR 5.25.





UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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Chicago IL 60611

In re: Rodriguez : DECISION ON REQUEST  
Serial No.: 10/743,644 : UNDER 37 CFR 5.25  
Filing date: December 22, 2003  
Docket No: 0110-0001

**Title: CORDLESS TELEPHONE-TO-SOUND CARD INTERFACE ADAPTER  
HAVING A HYBRID TRANSFORMER CIRCUIT**

This is a decision on the petition filed on April 21, 2004 for retroactive foreign filing license.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
  - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
  - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
  - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

The petition is denied since none of the requirements of 37 CFR 5.25 (1) (2) and (3)(ii-iii) have been met.

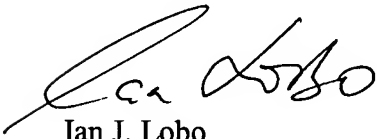
First, under 37 CFR 5.25 (1)(2) a listing, of each of the foreign countries in which the unlicensed patent application was filed and the dates on which the material was filed in each country is required.

Second, the petition is denied under 37 CFR 5.25 (3)(ii-iii). In order to secure a retroactive foreign filing license, applicant or petitioners must provide evidence that the subject matter was filed abroad through error and without deceptive intent. The instant petition fails in that it lacks sufficient evidence to conclude that the material was filed abroad through error and

without deceptive intent. Sufficient evidence would include a verified statement or statements by the person or persons (in the instant case the British counsel) who had knowledge and made the actual decision to file. Such a statement should reference the error of not obtaining a foreign license. Statements of error must be supported by fact. They should not be merely conclusionary but must include how and why the error occurred.

Finally, the instant petition does not include a copy of the application, in English, that was filed abroad.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within **60 days** of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).

A handwritten signature in black ink, appearing to read 'Ian J. Lobo', is positioned above the printed name.

Ian J. Lobo  
Patent Examiner  
(703) 306-4161



**Instituto  
de la Propiedad  
Industrial**



- ☒ Solicitud de Patente  
☐ Solicitud de Registro de Modelo de Utilidad  
☐ Solicitud de Registro de Diseño Industrial
- ☐ Modelo Industrial ☐ Diseño Industrial

Uso exclusivo Delegaciones y Subdelegaciones de la Secretaría de Economía y Oficinas Regionales de IMPI

Seño

Folio de entrada

Fecha y hora de recepción

**INSTITUTO MEXICANO DE  
LA PROPIEDAD INDUSTRIAL**  
 Dirección Divisinal de Patentes

Expediente: PR/a/2883/885992  
 Fecha: 2/JUL/2003 Hora: 11:43  
 Folio: PR/E/2883/825784



Antes de llenar la forma leer las consideraciones generales al reverso

**DATOS DEL (DE LOS) SOLICITANTE(S)**

- I
- El solicitante es el inventor ☒ El solicitante es el causahabiente ☐
- 1) Nombre (s): L. Ricardo Rodríguez de la Garza
- 2) Nacionalidad (es): Mexicana
- 3) Domicilio; calle, número, colonia y código postal: 10 Sterling Circle Apt 102, Wheaton Illinois, 60187 E.U.A.
- Población, Estado y País: Wheaton Illinois, Estados Unidos de América.
- 4) Teléfono (clave): (630) 682 8131 5) Fax (clave):

**DATOS DEL (DE LOS) INVENTOR(ES)**

- II
- 6) Nombre (s): L. Ricardo Rodríguez de la Garza
- 7) Nacionalidad (es): Mexicana
- 8) Domicilio; calle, número, colonia y código postal: 10 Sterling Circle Apt 102, Wheaton Illinois, 60187 E.U.A.
- Población, Estado y País: Wheaton Illinois, Estados Unidos de América
- 9) Teléfono (clave): (630) 6828131 10) Fax (clave):

**DATOS DEL (DE LOS) APODERADO(S)**

- III
- 11) Nombre (s): Arturo Bustamante Lorañca, Rafael J. Mendoza Ruiz, Fernando Rodríguez de la Garza, ✓ 12) R.G.P.: Santa Esther Jafite Villalón
- 13) Domicilio; calle, número, colonia y código postal: Montes Urales 470 Primer Piso Col. Lomas de Chapultepec C.P. 11000
- Población, Estado y País: México Distrito Federal, México
- 14) Teléfono (clave): 55408063 15) Fax (clave):
- 16) Personas Autorizadas para oír y recibir notificaciones:

**17) Denominación o Título de la Invención:**

Adaptador de Telefonía Internet Inalámbrico

**18) Fecha de divulgación previa**

Día Mes Año

**19) Clasificación Internacional**

uso exclusivo del IMPI

**20) Divisinal de la solicitud**

Número

Figura jurídica

Fecha de presentación

**21) Fecha de presentación**

Día Mes Año

**22) Prioridad Reclamada:**

País

Día

Mes

Año

Nº. de serie

2) Nacionalidad (es): Mexicana

3) Domicilio, calle, número, colonia y código postal: 10 Sterling Circle Apt 102, Wheaton Illinois, 60187 E.U.A.

Población, Estado y País: Wheaton Illinois, Estados Unidos de América.

4) Teléfono (clave): (630) 682 8131

5) Fax (clave):

### DATOS DEL (DE LOS) INVENTOR(ES)

6) Nombre (s): L. Ricardo Rodríguez de la Garza

7) Nacionalidad (es): Mexicana

8) Domicilio, calle, número, colonia y código postal: 10 Sterling Circle Apt 102, Wheaton Illinois, 60187 E.U.A.

Población, Estado y País: Wheaton Illinois, Estados Unidos de América

9) Teléfono (clave): (630) 6828131

10) Fax (clave):

### DATOS DEL (DE LOS) APODERADO(S)

11) Nombre (s): Arturo Bustamante Loranca, Rafael J. Mendez Ruiz, Fernando Rodríguez de la Garza, ✓ 12) R G P:  
Samia Esther Jaspe Vilalort

13) Domicilio, calle, número, colonia y código postal: Montes Urales 470 Primer Piso Col. Lomas de Chapultepec C.P. 11000

Población, Estado y País: México Distrito Federal, México

14) Teléfono (clave): 55408063

15) Fax (clave):

17) Denominación o Título de la invención:  
Adaptador de Telefonía Internet Instantáneo

18) Fecha de divulgación previa

Día Mes Año

19) Clasificación Internacional

uso exclusivo del IMPI

20) Divisoral de la solicitud

Número

Figura jurídica

Fecha de presentación  
Día Mes Año

21) Fecha de presentación

Día Mes Año

22) Prioridad Reclamada:

País

No. de serie

### Lista de verificación (uso interno)

No. Hojas

1	8
2	8
3	2
4	1
5	2

Comprobante de pago de la tarifa  
Descripción y reivindicación (es) de la invención  
Dibujo (s) en su caso  
Resumen de la descripción de la invención  
Documento que acredite la personalidad del apoderado

No. Hojas

1
1
1
1
1
15

Documento de cesión de derechos  
Constancia de depósito de material biológico  
Documento (s) comprobatorio(s) de divulgación previa  
Documento (s) de prioridad  
Traducción  
TOTAL DE HOJAS

Observaciones:

Bajo protesta de decir verdad, manifiesto que los datos asentados en esta solicitud son ciertos.

ARTURO BUSTAMANTE LORANCA

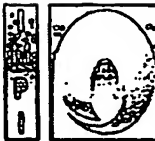
Nombre y firma del solicitante o su apoderado

MEXICO, D.F. a 2 de Julio de 2003

Lugar y fecha

IMPLM-001

Instituto  
Mexicano  
de la Propiedad  
Industrial



México, D.F., 2 de Julio del 2003

Solicitud No. \_\_\_\_\_ Inicial ( )

Bajo protesta de decir la verdad declaro con respecto al beneficio en las disposiciones Generales cláusula Cuarta (fracción III) de la tarifa por los servicios que presta es H. Instituto, de encontrarme en el supuesto abajo señalado, por lo que solicito el 50% de descuento de la tarifa establecida para el Artículo 1 A.

Hago la presente declaración en cumplimiento de dicho artículo, según el acuerdo por el que se da a conocer la tarifa por los Servicios que presenta el Instituto Mexicano de la Propiedad Industrial, publicado en el Diario Oficial de la Fracción con fecha 15 de marzo de 2002.

Marque con una (X)

Inventos o persona física ☒

Micro o pequeña industrial ( )

Instituciones de educación superior públicas o privadas ( )

Instituciones de Investigación Científica y Tecnológica del Sector Público ( )

ATENTAMENTE,

Nombre: Arturo Bustamante Lorenzana

Firma: Arturo BL



SOLICITANTE ( )

APODERADO (X)

## PODER

SRES.: ARTURO BUSTAMANTE LORANCA, RAFAEL J. MENDOZA RUIZ,  
FERNANDO RODRIGUEZ DE LA GARZA, SAMIA ESTHER JALIFE VILLALON

Caballeros:

Por medio de la presente confiero a ustedes poder general para pleitos y cobranzas y para actos de administración, para ejercerlo conjunta o separadamente, en términos del primero y segundo párrafos del artículo dos mil quinientos cincuenta y cuatro del Código Civil Federal, con todos los poderes especiales y generales que requieran de cláusula especial de conformidad con el artículo dos mil quinientos ochenta y siete del mismo ordenamiento y de sus correlativos a los artículos dos mil quinientos cincuenta y cuatro y dos mil quinientos ochenta y siete que sean aplicables en todos los Estados de la República Mexicana.

Sin limitar la generalidad de lo anterior, el poder antes mencionado podrá ser ejercitado ante toda clase de personas físicas y autoridades, ya sean federales, estatales, o municipales; organismos descentralizados o de participación estatal mayoritaria, así como ante autoridades administrativas, militares, laborales y judiciales. Sin limitar la generalidad de lo anterior, este poder otorga facultades específicas a mis representantes arriba descritos, para presentar y llevar todos los procedimientos necesarios para la obtención, registro y publicación de mis patentes, modelos de utilidad, marcas, nombres comerciales, avisos comerciales, diseños y modelos industriales, derechos de autor y reservas; la inscripción de cesiones de derechos en mi favor; renovaciones normales y especiales de mis registros; comprobación de uso o explotación de mis marcas, patentes y otros de derechos de propiedad industrial e intelectual; exámenes de novedad; pago de impuestos y derechos.

Este poder es otorgado el 13 de Junio de 2003, en la Ciudad de México, D.F.



(firma ilegible)

Por:

L. Ricardo Rodríguez de la Garza  
10 Sterling Circle, Apt 102

*Blanca E. Hefferan de Rodríguez*

\_\_\_\_\_  
(firma ilegible)  
(Testigo)

Nombre: Blanca E. Hefferan de Rodríguez  
Domicilio: Av. México No. 1256, Casa 120  
Col. Santa Teresa,  
Del. Magdalena Contreras,  
México, D.F. 10710



\_\_\_\_\_  
(firma ilegible)  
(Testigo)

Nombre: Mónica Rodríguez Hefferan  
Domicilio: Av. México No. 1256, Casa 120  
Col. Santa Teresa,  
Del. Magdalena Contreras,  
México, D.F. 10710

Nota: Este poder debe contener el nombre completo y domicilio completo de los testigos.